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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 764

AMERICAN AIR FILTER COMPANY, INC.,
Petitioner,

v.

CONTINENTAL AIR FILTERS, INC.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

AMERICAN AIR FILTER COMPANY, INC.,
Petitioner,

v.

CONTINENTAL AIR FILTERS, INC.,
Respondent.

No.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

American Air Filter Company, Inc. petitions that a writ of certiorari issue to review a judgment of the United States Court of Appeals for the Sixth Circuit, affirming a judgment of the United States District Court for the Western District of Kentucky which held Rivers Patent No. 2,807,330 invalid.

OPINIONS BELOW

The opinion of the District Court is reported at 226 F. Supp. 482 and its findings and conclusions are printed in the Appendix hereto, *infra*, pp. 1a-5a. The opinion of the Court of Appeals is reported at 347 F. 2d 931.

JURISDICTION

The judgment of the Court of Appeals was entered on June 25, 1965. A timely petition for rehearing was denied

on August 26, 1965. The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

QUESTION PRESENTED

Does the inclusion of the phrase "invents or discovers" in § 101 of Title 35 of the United States Code empower a Court to invalidate a patent for want of "invention" by the superposition of conditions for patentability additional to that expressly set forth in 35 U. S. C. § 103.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The eighth clause of Article I, Section 8 of the United States Constitution and Sections 101-103 and 282 of Title 35 of the United States Code are involved herein and are printed on a fold-out sheet following the Appendix hereto.

STATEMENT OF THE CASE

The legal bases of the decisions below necessitate a close correlation of the history of this action with the history of a now concluded companion infringement action on the same patent,[1] *American Air Filter Co. Inc.* v. *Farr Company,*

[1]Rivers patent No. 2,807,330 relates to industrial air filtration. The patent has apparently been cursed by the retrospective simplicity of its defined difference over the prior art, as exemplified by claim 2, as being no more than a new and extremely simple mode of manipulative operation of specified filter media in industrial air filters. Despite its simplicity, the patent broke a developmental log jam of many years standing, resulted in the creation of an entirely new class of automatic industrial air filters, provided results and advantages not theretofore obtainable, met with a spontaneous, immediate and widespread demand from industry which not only displaced prior art devices but realized to petitioner alone sales approaching thirty million dollars in a ten year period and forced copying by competitors in response to the demands of their sales organizations therefor (See plaintiffs proposed findings below and citations to record included herein as presented in the Record on Appeal at pages 43a-45a thereof.)

Civil No. 858-58Y, Southern District of California. The District Court opinion, findings and conclusion in the Farr Co. case are unreported and are printed in the Appendix hereto, *infra*, pp. 6a-31a. The Court of Appeals decision is reported in *Farr Company* v. *American Air Filter Company, Inc.*, 318 F. 2d 500 (C. A. 9, 1963); c. d. 375 U. S. 903 (1963).

Trial was had below in May, 1959 immediately following the California District Court trial of the Farr Co. case in which the Rivers patent was found to be valid and infringed. Detailed findings of fact, conclusions of law and judgment were entered in the Farr case on July 22, 1959 (*infra*, pp. 9a-31a). The Ninth Circuit Court of Appeals took almost four years to decide the Farr case appeal and during the pendency of that appeal the District Court below held this case under submission. The total time here involved between trial and judgment was well over four years.

In reversing the lower Court in the Farr case on the sole ground of lack of "invention", the Ninth Circuit Court recognized that novelty was present (318 F. 2d 500 at 503), accepted the facts found below (p. 502)[2] and posed its view of the sole and critical issue as follows (pp. 502, 503)

> "Whether Rivers' contribution is of sufficient novelty to be patentable is therefore a question of law, based upon the rule that a combination of old elements is patentable invention only if the elements take on some new quality or function by being brought into concert and their combination results in unusual or surprising consequences."

and then based their conclusion of lack of invention on the assertion that (p. 503):

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[2]Including express findings of new function and new mode of operation and of non-obviousness to those skilled in the art (Finding 48, p. 26a; Finding 60, p. 28a). See also Findings 40-61; pp. 23a-28a.

> ". . . we are unable to perceive that any of the requisite unusual or surprising consequences resulted."

Shortly thereafter, the District Court below held Rivers patent No. 2,807,330 invalid and stated as the sole basis for such conclusion (226 F. Supp. 482 at 483):

> "The ruling and the reasoning in the opinion of *Farr Co.* v. *American Air Filter Co. supra,* is adopted as the law of the case."

The findings subsequently formulated by defendant were admittedly "within the framework of the Farr opinion" and are essentially nothing but either quotes from or slightly paraphrased extracts of such opinion. Nowhere therein is any express statement of lack of novelty of the claimed subject matter (cf. 35 U. S. C. § 102) or that such was obvious to anyone skilled in this art (cf. 35 U. S. C. § 103).

The District Court's complete derogation of the statutory criteria is emphasized by its first conclusion of law (*infra,* p. 4a):

> "The standard of patentability is a constitutional standard; and the question of the validity of a patent is a question of law."

In affirming the District Court, the Sixth Circuit Court of Appeals stated (347 F. 2d 931 at 932):

> Fair reading of the District Judge's reported opinion together with his conclusions of law and the opinion of the Ninth Circuit makes it clear that invalidity was adjudged because of the conclusion that *as a matter of law* the patentee, Rivers, really did not *invent or discover* anything when he put together the patented mechanism. 35 U.S.C.A. § 101. We agree

with the District Judge and the Ninth Circuit and, therefore, affirm.

* * *

* * * As stated by the Ninth Circuit, the patentee, Rivers, "did contribute something to the art" and the sole question is whether such contribution constituted patentable invention, 35 U.S.C.A. § 101. . . ."[2]

As is apparent from the foregoing, the Court of Appeals expressly relies upon § 101 of Title 35 U. S. C. and in particular to the phrase "invents or discovers" therein as its basis for affirming the District Court's belated adoption of the "ruling and the reasoning" of the Ninth Circuit and derivative invalidation of the Rivers patent by superposition of an additional and precedent "condition" for patentability to those set forth in § 102 and § 103 of the Statute.

REASONS FOR GRANTING THE WRIT

This petition raises an important question of federal law concerning the scope of judicial power in relation to the administration of the patent law which has not been, but should be, decided by this Court.

A. The Present Patent Statute and Its Background

Patents in the United States exist only by virtue of statutes enacted by Congress pursuant to the enumerated power set forth in Art. I, § 8 of the Constitution. (See fold out sheet at rear)

Under such power Congress has plenary authority to enact all laws consistent with the specified purpose of pro-

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[2]The Court later buttressed its conclusion by asserting that the subject matter was obvious and erroneously ascribed such a holding to both the Ninth Circuit and to the Kentucky District Court. The action of the District Court actually denied petitioner the express resolution of this issue. Cf. District Court opinion and findings, *infra* p. 1a-5a. ct. also 318 F. 2d 500.

moting *"the progress of science and useful arts"*, and which, in its judgment, will be best calculated to effect that object. In *United States* v. *Duell*, 172 U. S. 576, 583 (1898), this Court said:

> "Since, under the Constitution, Congress has power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries,' and to make all laws which shall be necessary and proper for carrying that expressed power into execution, it follows that Congress may provide such instrumentalities in respect of securing to inventors the exclusive right to their discoveries *as in its judgment will be best calculated to effect that object.*"

None of the predecessor statutes to the 1952 Act set forth any statutory "standard of invention" as a condition for patentability.[4] The requirement of "invention" was initially of judicial origin and had its genesis in *Hotchkiss* v. *Greenwood*, 52 U. S. (11 How.) 248 (1850). That decision introduced both the "requirement" of "invention" and set a "standard" therefor in terms of "a degree of skill and ingenuity" as follows:

> . . . . . for unless more ingenuity and skill in applying the old method . . . were required than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree

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[4]See, e.g., Edwards, *Efforts To Establish A Statutory Standard of Invention*, Study No. 7, Subcomm. on Patents, Trademarks and Copyrights, Senate Comm. on the Judiciary, 85th Cong., 1st Sess. 1-2 (Comm. Print 1958); Frost, *The Patent System And The Modern Economy*, Study No. 2, Subcomm. on Patents, Trademarks and Copyrights, Senate Comm. on the Judiciary, 84th Cong., 2nd Sess. 47-60 (Comm. Print 1957).

> of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skilful mechanic, not that of the inventor. (52 U. S. at 266)

The reasoning of this case and what followed was the injection into the law of what has ever since been called a requirement for "invention." Generally, this Court applied this requirement of invention, albeit with some verbal variances, in the ensuing years. See, e.g., *Dunbar* v. *Meyers*, 94 U. S. 187, 197-200 (1876); *McClain* v. *Ortmayer*, 141 U. S. 419, 425-29 (1891); *Expanded Metal Co.* v. *Bradford*, 214 U. S. 366, 381 (1908); *Eibel Process Co.* v. *Minn. & Ontario Paper Co.*, 261 U. S. 45, 63 (1923). Other verbal variants made their appearance and were such as to be later readily arguable as representing marked departures from the *Hotchkiss* v. *Greenwood* requirement. See *Smith* v. *Whitman Saddle Company*, 148 U. S. 674, 681 (1893); *Potts* v. *Creager*, 155 U. S. 597, 607 (1894); *Mantle Lamp Co.* v. *Aluminum Products Co.*, 301 U. S. 544, 546 (1936).

In the more recent years prior to 1952, the terminology and associated comments employed by this Court relative to the delineation of the requirement of "invention" elevated them into "standards" which differed from those of earlier cases. See *Lincoln Co.* v. *Stewart Warner Corp.*, 303 U. S. 545, 549 (1938); *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 91 (1941). Such terminology, coupled with the associated comments in *Great A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147 (1950), created serious questions as to uniformity and definiteness of the requirements for patentability in the lower courts and, more importantly, as to whether the requirements or standards of "invention" were being judicially raised to a level that would impede, rather than promote, the progress of useful arts.

At least in partial response to the above, Congress, in the late 1940's, considered the enactment of a statutory standard of invention.[5] These efforts culminated in the enactment, in 1952, of §§ 101, 102 and 103 of Title 35 of the United States Code (printed on the fold-out sheet following the Appendix hereto).

As noted in both the Senate and House Reports on the subject legislation, "Section 101 sets forth the subject matter that can be patented, 'subject to the conditions and requirements of this title.' The conditions under which a patent may be obtained follow, and Section 102 covers the condition relating to novelty."[6] Section 102 significantly uses mandatory language—"A person shall be entitled to a patent unless . . ."

The Senate and House reports also state:

> There are a number of changes in substantive statutory law. . . . The major changes or innovations in the title consist of incorporating a requirement for invention in § 103 . . .[7]

With respect to § 103, the Reports state:

> Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of

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[5]See Edwards, *supra* note 4 at 2-15.

[6]S. Rep. No. 1979, 82nd Cong., 2nd Sess. 5 (1952); H. R. Rep. No. 1923, 82nd Cong., 2nd Sess. 6 (1952).

[7]*Id.*, S. Rep. at 4; H. R. Rep. at 5.

> the Courts and in writings. Sec. 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.[8]

and as to the intent and purpose of Congress the Reports continue:

> "That provision paraphrases language which has often been used in decisions of the Courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases."[9]

It seems clear from the above that, in the 1952 Act, Congress enacted a comprehensive statute which explicitly delineates the "conditions and requirements" for *patentability* and which included, in addition to novelty (§ 102) an expressly defined statutory requirement for, and standard of, "invention" as one of the conditions for patentability.

The public interest is dominant in the patent system. *Mercoid Corp.* v. *Mid-Continent Investment Co.*, 320 U. S. 661, 665 (1944). But the legislature is the prime guardian of the public interest. This was recognized in *Berman* v. *Parker*, 348 U. S. 26 at 32 (1957):

> "* * * Subject to specific constitutional limitation, when the legislature has spoken, the public

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[8] *Id.*, S. Rep. at 6; H. R. Rep. at 5.
[9] *Id.*, S. Rep. at 6; H. R. Rep. at 5.

interest has been declared in terms well-nigh conclusive. * * *"[10]

It is settled law, both as a general proposition and with respect to other enumerated powers of Congress, that where Congress has acted, judicial power is effectively limited to the determination of whether the legislature, in what it has prescribed, has gone beyond constitutional limits. In this determination the Court is not concerned whether the action taken was wise or expedient. *Gibbons* v. *Ogden,* 22 U. S. (9 Wheat.) 1, 196-7 (1824); *NLRB* v. *Jones & Laughlin Steel Corp.,* 301 U. S. 1, 46 (1936); *Helvering* v. *Davis,* 301 U. S. 619, 640 (1937); *Guaranty Trust Co.* v. *Henwood,* 307 U. S. 247, 259 (1939); *Polish Alliance* v. *NLRB,* 322 U. S. 643, 650-1 (1944); *United States* v. *Twin City Power Co.,* 350 U. S. 222, 224 (1956); *Railway Employe's Dept.* v. *Hanson,* 351 U. S. 225, 234 (1956); *Sinclair Refining Co.* v. *Atkinson,* 370 U. S. 195, 214-5 (1962).[11] It is also recognized that the judicial power does not extend to engraftment to, or superimposition on, legislative action. *Dewey* v. *United States,* 178 U. S. 510, 520-1 (1900); *Electric Battery Co.* v. *Shimadzu,* 307 U. S. 5, 14 (1939); *United States* v. *American Union Transport, Inc.,* 327 U. S. 434, 456-7 (1946).

By its enactment of the 1952 Patent Act and including, *inter alia,* § 101, 102 and 103 thereof, Congress has preemptively defined the "conditions and requirements" for patentability. § 101 explicitly defines particular types and nature of subject matter that can be patented and § 102

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[10]Cf. Local 1976 v. N. L. R. B., 357 U. S. 93, 100 (1958).

[11]See *United States* v. *Darby,* 312 U. S. 100, 115-6 (1940); *Secretary of Agriculture* v. *Central Roig Refining Co.,* 338 U. S. 604, 618, 619 (1950); *FTC* v. *Simplicity Pattern Co.,* 360 U. S. 55, 67-8 (1959); *Barenblatt* v. *United States,* 360 U. S. 109, 132 (1959).

"covers the condition relating to novelty" (*supra* p. 8). Section 103 pre-emptively defines the statutory requirement of "invention" as a condition for patentability in terms of obviousness, and the exclusivity of such condition for patentability is further emphasized by the concluding sentence of the section and by the Revision Notes which express a Congressional negation of certain previously enunciated judicial criteria,[12] as follows:

> "Patentability shall not be negatived by the manner in which the invention was made."

The Revision Note states:[13]

> "The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius."

The exclusive nature of the Congressionally defined "conditions and requirements" for patentability is confirmed by the express wording of § 282 which enumerates the defenses available in patent actions and specifically refers to:

> (2) "Invalidity of the patent or any claim in suit on any ground specified in Part II of this title as a condition for patentability,
>
> (3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,"

In the light of the foregoing, we submit that Congress, by passage of the 1952 Patent Act, pre-empted the field

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[12]Cf. *Cuno Engineering Corp.* v. *Automatic Devices*, 314 U. S. 84 (1941).

[13]U. S. Cong. & Adm. News 1952, page 2411.

and so circumscribed the power of the federal courts as to preclude their enunciation of any additional conditions for patentability or standards of "invention" and thus effectively limited the function of such courts to the application of the Congressionally enacted "conditions and requirements" therefor.

In the case at bar, the Court of Appeals justifies the superposition of a judicially enunciated "standard of invention" as a precedent "condition" for patentability by virtue of the presence of the terms "invents or discovers" in § 101 of the statute. By such action the Court below is necessarily ascribing a full equivalency in meaning between the terms "invention" and/or "discovery" (as the base nouns for the § 101 verbs "invents or discovers") and *patentability*. The error inherent therein is made apparent by the plain meaning of the terms in question and the fact that the remainder of the § 101 terminology makes obvious the circuity of logic involved. The error is also made apparent by the further fact that any such asserted equivalency of meaning effectively robs §§ 102 and 103 as well as numerous other sections of the statute of any effect or meaning and thereby renders the Congressional action taken in enacting this legislation a nullity.

Petitioner submits that the Court of Appeals for the Sixth Circuit has improperly superposed conditions and requirements for patentability upon those specified by the legislature and that such action was beyond the scope of its judicial power and requires reversal by this Court.

B. The Importance of the Question

Congressional committee studies and legal commentators have indicated the mounting concern with the unsettled condition of the patent law, possible disillusionment due to the

high mortality rate of patents and the uncertainty and expense incumbent upon participants in patent litigation.[14] The focal point of trouble is not difficult to recognize. It is described in a recent Staff Report of the Subcommittee on Patents, Trademarks and Copyrights of the Senate Committee on the Judiciary:

> The annual reports of the subcommittee have noted the continuing gap between the views of the Patent Office and the U. S. courts as to what is and what is not patentable. No significant improvement in this situation has been observed since the enactment of section 103, which defines the standard of invention in the Patent Act of 1952. Viewed from the experience of the past 6 years, the statement in the Senate report of 1952 that section 103 "should have a stabilizing effect and minimize great departures which have appeared in some cases," appears unduly optimistic.
>
> Not only is the standard of invention clouded in uncertainty but the various circuits are unable even to agree as to the legislative intent expressed in section 103. One view holds that the standard of patentability was unchanged by the enactment of section 103, while the other position is that it was the intent of Congress to relax the rigid test of patentability laid down by the Supreme Court.[15]

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[14]Bush, *Proposals For Improving The Patent System*, Study No. 1, Subcomm. on Patents, Trademarks and Copyrights, Senate Comm. on The Judiciary, 84th Cong., 2d Sess. 1-7, 18-19 (Comm. Print 1956; Frost, *supra* note 3 at 58-60; STAFF OF SUBCOMM. ON PATENTS, TRADEMARKS AND COPYRIGHTS, SENATE COMM. ON THE JUDICIARY, 86TH CONG., 2D SESS., AN ANALYSIS OF PATENT LITIGATION STATISTICS iii, 1-2, 6 (Comm. Print 1961).

[15]AN ANALYSIS OF PATENT LITIGATION STATISTICS, *supra* note 14, at 1.

Analyses of the situation by case compilation by circuit have been made by Congress[16] and by others[17]. These analyses have revealed widespread doctrinal diversity among the various curcuits not only as to the effect of the 1952 Act but also in the application of the so called judicial "standards" of invention. In fact, one of the very problems that Congress was attempting to solve by the 1952 Act was the wide doctrinal diversity that had developed in the application of the judicially defined "standards of invention", which, apart from the recognized semantic problems involved,[18] posed essentially varying subjective criteria that inherently resulted in wide variation in result as applied to differing facts by differing judges or even, as here, as applied to similar facts by different judges.

In the recent case of *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U. S. 225, 231 (1964), this Court, per Mr. Justice Black, again recognized that under the Constitution it is Congress that determines the national policy with respect to patents and that such policy should be applied uniformly throughout this country. Congressional policy is incorporated in the 1952 Act which preemptively establishes the test of obviousness to "a person having ordinary skill in the art . . ." as the "condition for patent ability" for uniform application by the triers of the facts in the District Courts throughout the country.

While this Court has recently recognized the unsettled condition of the patent law and has heard argument in several cases involving § 103 of the Statute, petitioner submits that none of such cases raised the basic question here presented and whose resolution is essential to permit the

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[16]Edwards, *supra* note 3, at 17-24; AN ANALYSIS OF PATENT LITIGATION STATISTICS, *supra* note 14.

[17]NOTE, 63 COLUM. L. REV. 306 (1963); Chin. *The Statutory Standard of Invention: Section 103 of the 1952 Patent Act*, 3 J. R. E. 317 (1959).

[18]See, *Great A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147 at 150-1 (1950).

1952 Patent Act to function to promote "the progress of science and the useful arts, . . ."

It is submitted that the foregoing clearly demonstrates the importance of the question presented and the making of this case an appropriate vehicle for the grant of certiorari.

CONCLUSION

For the reasons stated, this Petition for a Writ of Certiorari should be granted.

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APPENDIX

Findings of Fact and Conclusions of Law

IN THE

UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF KENTUCKY
AT LOUISVILLE

AMERICAN AIR FILTER COMPANY, INC., *Plaintiff,* v. CONTINENTAL AIR FILTERS, INC., *Defendant.*	Civil Action No. 3534

FINDINGS OF FACT

1. Plaintiff, American Air Filter Company, Inc., and defendant, Continental Air Filters, Inc., are both corporations of Delaware having regular and established places of business at Louisville, Kentucky.

2. This is a suit for infringement by defendant of United States Letters Patent No. 2,807,330 issued to plaintiff on September 24, 1957, as assignee of Richard D. Rivers, for "Method and Apparatus for Filtering Air". Since that date plaintiff has been and still is the owner of said Letters Patent.

3. This Court has jurisdiction of the parties and the subject-matter of the action.

4. The Rivers patent relates to a device for filtering air. The device, as disclosed, is a roll filter which comprises (1) a frame having an upper portion in which is mounted a rolled up supply of a web-like filter media, (2) a central, open, air filtering area across which the web of filter media is moved by a conveyor and where the air to be filtered is moved through the media and (3) a take-up roll located beneath the filtering area and onto which the dirtied media is rewound. The web of media used in the device of the patent is "expansible-compressible". It is wound on the supply roll under compression, expands as it leaves the supply roll, remains expanded in the air filtering area and is re-compressed as it is re-wound on the take-up roll.

5. The Rivers patent contains five claims; they define a roll of filter webbing, a method of manipulating the webbing in a roll-type filter, and a filter apparatus. Specifically, Claim One claims a preformed supply roll consisting of a strip of "expansible-compressible" webbing tightly wound on a mandrel or spool so as to be compressed to less than half its expanded thickness. Claims Two and Three claim the method for progressively removing and expanding from the supply roll the "expansible-compressible" web, moving it through an air stream and thereafter progressively re-compressing and winding the used web onto a take-up spool to form a disposable package; and Claims Four and Five claim a means to condition and manipulate the webbing in the manner specified in Claims Two and Three.

6. Roll filters were not new in the art. The concept of placing a web of filter media in roll form and feeding this web from its supply roll across an air stream and thereafter rerolling the dirtied web into a roll which could be thrown away was taught by plaintiff's earlier commercially sold roll

filter designated "Auto-Airmat" and by prior patents exemplified by Christofferson No. 1,982,639 and Dollinger 2,016,991. The "Auto-Airmat" used a thin diaphanous paper media in roll form. Christofferson describes a webbing composed of "very finely carded cotton fiber" which is "loosely felted" and "of exceptionally low resistance to the passage of air therethrough while at the same time having maximum efficiency in removing impurities". Dollinger describes a roll filter material of "extremely fine fibers of paper, cotton, wool, asbestos, etc., lightly held together to form a relatively thick filtering medium in a very loose or porous condition".

7. The "expansible-compressible" filter media disclosed in the specification of the Rivers' patent is a fibrous glass web of the type which plaintiff had manufactured and had sold under the designation "Amer-glas". Prior to the date of the Rivers' conception pads of this media and webs of it in roll form had been compressed by plaintiff to save space in handling, storage and shipment. This media, in the form of pads, as purchased, or cut from rolls and inserted in unit filter frames, was used by purchasers for filtering air, but the record does not disclose the prior use of that media in roll type filter apparatus.

8. The filter media suggested by Rivers for use in a roll type filter apparatus had the same air filtering properties when used in such an apparatus as when used in unit air filter frames prior thereto. Its use in a roll filter brought no improved result in the cleaning of air.

9. In addition to plaintiff's "Amer-glas", various other types of filter media had been employed in unit filter frames. A unit air filter is much less convenient than a roll filter; the former employs a single section or pad of webbing,

rigidly held in a frame or cell, which must be manually replaced at relatively frequent intervals.

10. There was nothing unusual or surprising about a compressed supply roll of "expansible-compressible" webbing wound on a mandrel, as claimed in claim 1 of the patent. Long before Rivers' conception this particular kind of webbing or media was not only known and in general use for filtering air, but also was commonly wound in tight rolls to facilitate handling and storage. The Rivers patent taught the winding of webbing on a spool in the usual way that elongate strips of material are wound on spools and it is clear that neither the web nor the spool took on new qualities or functions by being so brought into concert.

11. Rivers did not achieve any unusual or surprising consequences by the series of steps of manipulating an old air filter material in an old air filter apparatus by the method which he claimed in the patent (claims 2 and 3); nor in the means which he claimed for practicing that method (claims 4 and 5). The means was no better than the method.

12. In view of the Court's opinion and the conclusions herein that the claims of the patent are invalid for lack of patentable invention, no findings are made with respect to other defenses urged by defendant against the validity of the patent in suit.

CONCLUSIONS OF LAW

1. The standard of patentability is a constitutional standard; and the question of the validity of a patent is a question of law.

2. The nature of Rivers' contribution in view of the state of the prior art does not meet the standards of patentable invention.

3. Each of the claims of the patent in suit is invalid. *Farr Company* v. *American Air Filter Company, Inc.*, 318 F. 2d 500 (C. A. 9).

4. Where patentable invention is clearly lacking, factors, such as commercial success, which may tip the scales in favor of invention where the question is close and the court in doubt, do not make for patentability. *Farr Company* v. *American Air Filter Company, Inc.*, supra.

5. The complaint should be dismissed with prejudice with costs to defendant.

Dated this 3rd day of October, 1963.

HENRY L. BROOKS
United States District Judge

Copies to:

Squire R. Ogden
Keith, Bolger, Isner & Byrne
Carl F. Schaffer
Peter, Heyburn & Marshall
10-4-63 lm

Decision

IN THE

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA
CENTRAL DIVISION

AMERICAN AIR FILTER COMPANY, INC., *Plaintiff,* *vs.* FARR COMPANY, *Defendant.*	Civil Action No. 858-58Y

DECISION

The above-entitled cause heretofore tried, argued and submitted is hereby decided as follows:

Judgment will be for the plaintiff that the patent in suit, United States Letters Patent No. 2,807,330, is good and valid in law and its claims are infringed by the defendant.

After Judgment shall have become final, question of damages will be referred to a Master, to be appointed by the Court.

Costs to the plaintiff. No attorneys' fees.

Findings and Judgment to be prepared by counsel for the plaintiff under Local Rule 7.

Comment

I am of the view that Patent No. 2,807,330 issued to R. D. Rivers on September 24, 1957, and duly assigned to the plaintiff is valid and infringed by the defendant's

device. My only misgivings as to the validity of the Patent [155] arose as to Claim 2, which reads:

> "2. In a method of filtering from an air stream solids borne thereby, the steps consisting of progressively removing and expanding from a compressed supply web thereof and expansible-compressible filter medium, moving the medium into and through said air stream and thereafter progressively recompressing the thus exposed medium, carrying the solids retained in it, into a disposable package."

And it concerned the question whether the Claim was sufficiently distinct as required by Section 111 of Title 35 U. S. C. A. A study of the matter, in the light of the voluminous record made in this case convinces me that the particular Claim read with the details in the specifications has the certainty required by law. This being so, it follows that the other Claims have similar certainty.

In my view, Rivers taught the art something which is not found in the prior art and, especially, in the Patent to Christofferson, No. 1,982,639 issued December 4, 1934, which the defendant's expert claims to contain more of the features of the patented device than any other. The fact is that the defendant did not copy Christofferson, which was before the Patent Examiner, or any of the additional ones referred to at the trial. They claim to have embodied a device described by the plantiff in one of its bulletins more than one year before the date of the application (15 U. S. C. A. § 102(a)). I am convinced that the defendant copied the device described in the patent. And if the commercial device manufactured by the plaintiff deviated from that described in the Patent, the plaintiff was entitled to avail itself of the doctrine of equivalents because the de-

Decision

vice described was only one of the modes [156] "contemplated by the inventor" for "carrying out his invention" (35 U. S. C. A. § 112).

Hence the ruling above made.

Dated this 2nd day of June, 1959.

/s/ LEON R. YANKWICH,
Judge. [157]

[Endorsed]: Filed June 2, 1959.

Findings of Fact and Conclusions of Law (*Farr* Case)

IN THE

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA
CENTRAL DIVISION

AMERICAN AIR FILTER COMPANY, INC., *Plaintiff,* *vs.* FARR COMPANY, *Defendant.*	Civil Action No. 858-58Y

Findings of Fact, Conclusions of Law and Judgment

Pursuant to Rule 52 of the Rules of Civil Procedure, this cause having come on for trial before this Court on May 13, 1959 before the Honorable Leon R. Yankwich, District Judge, and Plaintiff and Defendant having presented their evidence and having orally argued in support of their respective contentions, and this Court having entered its Decision herein dated June 2, 1959, and having directed counsel for Plaintiff to prepare Findings of Fact, Conclusions of Law, and Judgment pursuant to the provisions of Local Rule 7, the same are hereby adopted by the Court as its Findings of Fact, Conclusions of Law, and Judgment:

FINDINGS OF FACT

1. Plaintiff corporation is, and has been for many years, a manufacturer and seller of various air filters, dust collectors, and of air filtering and dust collecting systems.

2. Defendant corporation is, and has been for some years, a manufacturer and a seller of various air filters and air filtering systems.

3. The United States Patent in suit, No. 2,807,330, was issued to Plaintiff on September 24, 1957 as the assignee of the patentee, Richard D. Rivers; since that date Plaintiff has been and still is the owner of said patent.

4. Plaintiff has placed the required statutory marking on air filtering apparatus manufactured and sold by it under said United States Patent No. 2,807,330 since the date of issuance thereof.

5. Mr. Richard Rivers, a young physicist of very limited experience in the field of air filtration, conceived the patented inventions in January, 1953 while observing, as an onlooker, certain tests being performed by others in Plaintiff's research laboratory and with which tests he had no connection or responsibility.

6. After Rivers demonstrated that the patented inventions could be practically attained, the design of commercial units embodying the same was undertaken by Plaintiff's Development Department.

7. The patented inventions were thereafter embodied in commercial air filters manufactured and sold by Plaintiff. These filters were then and, for the most part, are now identified to the trade by Plaintiff as "Roll-O-Matic" filters. The initial sales to the trade of the Roll-O-Matic filter, known as the Model A, commenced in early 1954. The initial sales of a redesigned Roll-O-Matic filter, known as Model

B, to the trade commenced in December of 1956. Both the Model A and Model B Roll-O-Matic filters are constructed and operate in accordance with the teachings of the patent in suit and come within the scope thereof.

8. Defendant saw Plaintiff's "Roll-O-Matic" filter literature, and the methods described therein at least as early as the middle of 1956 and thereafter took steps to build and market a virtual copy thereof.

9. Defendant's infringement of the patent in suit was caused by the popularity of plaintiff's patented filters with the trade and by the demands of the Defendant's sales representatives for such a product.

10. Defendant first sold its infringing filters in January, 1957.

11. Defendant's copying of Plaintiff's filter and methods brought immediate success to Defendant and by November, 1958 Defendant had sold about 250 units.

12. The filtering of air, or other gas, to remove solid particulate matter borne thereby, is an old and crowded art.

13. Air borne solid particulate matter is broadly classified as "atmospheric dust" and "process dust". "Process dust" refers to all particulate matter generated by or associated with some industrial process, It is usually homogeneous in character, frequently covers a rather narrow range of particle sizes and usually occurs in high concentrations. The collection of lint in textile mills and paper dust and ink mist in newspaper press rooms are two examples of process dusts. "Atmospheric dust" refers to a

complex mixture of particulate matter commonly found in the atmosphere for the particular area or location in question. It generally covers a wide range of particle sizes, occurs in relatively low concentrations and is quite heterogeneous in nature. Its constituents vary with the geography of the location, the season of the year, the wind direction and other general factors. A sample of atmospheric dust at any one point will generally contain particles of practically every material common to the locality together with other wind borne particulate matter originating in distant places. Typical constituents may include minute particles of clay, silica, soot and carbon, decayed animal and vegetable matter, organic plant fibers, lint, pollen, mold spores, bacteria and other microorganisms. Atmospheric dust particles will range from submicron sizes, such as smokes, up to particles at the threshold of visibility, about 50 microns. There are 25,400 microns to the inch.

14. The problems encountered in removing atmospheric dusts from air are different from those encountered in the removal of process dusts. The removal of atmospheric dust from the air is a specialized art and the devices used to effect the removal of such atmospheric dust are known to those skilled in this art as "ventilating air filters".

15. The heart of a ventilating air filter is the filter medium. The filter medium is a structure or thing designed to allow the air to pass but to hold and retain such solid particulate matter as it is desired to remove from the air stream. To effect the desired filtering action in a ventilating air filter, the air is positively driven through the filter medium and the dirt particles borne in the air are

caused to contact the surfaces of the filter medium and to be retained thereby. Ventilating air filters for the removal of atmospheric dust have been broadly classified by the art in accordance with their operating characteristics and principle of operation as "viscous impingement type" filters, "dry type" filters, and "electrostatic type" filters. The choice of a particular type of ventilating air filter for effecting the removal of atmospheric dust depends upon a number of factors which include the desired degree of dust removal and pertinent practical and economic considerations.

16. The classical differences generally expressed by the separation of ventilating air filters into "viscous impingement type," "dry type" or "electrostatic type" by the art are as follows:

> "Viscous Impingement type" air filters generally use the higher range of conventional air velocities through the media—these being in the order of 300 to 500 feet per minute. They have a moderate order of effectiveness in the removal of the dust and a high order of dust holding capacity per unit of media area, all of which is quite satisfactory for many purposes. The media employed in such filters is generally formed of elements spaced relatively widely apart and in such wise as to give the media appreciable effective depth. Such configurations offer a relatively low resistance to air flow through the media and provide a high air handling capacity. The surfaces of the media elements are generally liberally coated or treated with some viscous material (often referred to as "oil") which serves to positively retain and hold dust particles which impinge on the coated or treated surface (i.e., in the manner of "fly paper").

"Dry type" air filters generally use, and are limited to, the lower range of air velocities—these being in the order of 10 to 100 feet per minute. They possess a relatively high order of effectiveness in the removal of dust and a generally low dust holding capacity per unit of media area. The media employed in such filters is generally formed of small elements spaced closely together to provide a dense mat-like structure with tortuous air paths therethrough and, generally, the elements are arranged in dense sheets of moderate or small depth. These configurations lend an inherent high resistance to air flow through the media and so limit air handling capacity. The surfaces of the elements forming the media are generally not treated with a viscous or oily substance, although in some instances small amounts of oil are employed to enhance performance.

"Electrostatic type" ventilating air filters, which were introduced about 1937, utilize an electrostatic force, rather than the driving action of the air, to effect impingement of the dust particle on the filter medium.

Filters which employ media which have been liberally coated or treated with a viscous or oily substance are often loosely called "viscous impingement filters". Those which do not utilize filter media which has been so coated or treated are often loosely called "dry" filters. In addition the term "dry" has been loosely used in other connotations, such as denoting an automatic viscous impingement type filter characterized by the absence of a bath or tank of oil.

17. Ventilating air filters of both the "viscous impingement type" and the "dry type" are further sub-classified by the art into "unit" or "automatic" air filters and each of these sub-classifications are further sub-divided into

"permanent" types and "disposable" types in accordance with whether the particular media employed was reconditionable by cleaning or whether it was thrown away and replaced by fresh unused media.

18. In the past 30 to 40 years many substances and structures have been proposed as filter media, but the practical art has generally used the following types of media:

—metal-membered media built up of metal plates, screens, wires or sheets

—filamentous media such as animal hair, metallic wool, glass fibers and, sometimes, vegetable fibers in kinked or shredded form

—paper, woven cloth or fabric felts and the like.

19. Regardless of whether an air filter is, or was, characterized as a "viscous impingement type" or "dry type" filter, air filters always present the problem of cleanliness in the sense that as the atmospheric dust accumulates on the filter medium during the filtering of the air there comes a time when the resistance to the flow of air, caused by this dirtying of the filter medium, increases beyond practical limits and, therefore, it becomes desirable to clean or renew the filter medium. This cleaning or maintenance problem, which is as old as the art of air filtering, involves maintenance, the possibility of improper maintenance or untimely maintenance and, further, usually necessitates the shutting down of the air filter during the cleaning or renewal process.

20. Prior to about the middle 1920's the viscous impingement type and dry type filters commercially used in

the filtering of atmospheric dust from air were largely of the "fixed", "panel", "cell", or "unit" type (hereinafter called "unit" type), these terms all denoting the fact that cleaning or renewing of the filter medium was not automatic but was accomplished by the shutting down of the filtering process at intervals to effect manual cleaning or replacement of the dirty filter medium.

21. In or about 1926 there first commercially appeared in this country the so-called "automatic" air filters. These were machines so designed as to automatically clean, renew or replace the filter medium, the objective being to decrease the day by day maintenance and attention, and to prevent, to a considerable extent, the necessity of shutting down the filtering process.

22. The automatic "dry type" of ventilating air filter is exemplified by the Mickle, Dollinger, Wolthuis, Birkholz and Christofferson patents, which were cited during the Patent Office prosecution of the patent in suit. These patents do not disclose the patented inventions or provide any teaching that might be considered to render the patented inventions obvious or apparent to those skilled in the art. These automatic "dry type" filters proved commercially unsuccessful as ventilating air filters for the removal of atmospheric dust, due to inherent air flow limitations and consequent limited air handling capacity where the media was disposed in a straight line across the air stream, and the practical difficulties of effecting the presentation of extended areas of filter media surface to the air stream in the air filtering zone by zig-zagging or pleating thereof.

23. The only true "dry type" automatic machines operating today are used for the collection of process dust. The

conventional type usually employs a bag or cylinder of a dense felted or fabric media and is cleaned by beating or blowing the accumulated process dust off the media surface from time to time. Another automatic machine which has been loosely and inappropriately termed a "dry type filter" and which is in successful operation today in the collecting of certain large sized process dusts in limited applications, such as textile mill lint and press room ink mist, employs an extremely thin, flimsy disposable paper filter media of a hybrid character that is, because of its porosity and thinness, devoid of practical utility in the filtering of atmospheric dust in the general ventilating field. Such a lint collector has, since 1950, been sold by plaintiff under the name "Auto Air-mat".

24. Plaintiff's "Auto Air-mat" unit, apart from being devoid of practical utility in the removal of atmospheric dust from air, did not, and does not, incorporate the inventions of the patent in suit nor did it provide any teaching that might be considered to render the patented inventions obvious or apparent to those skilled in the art.

25. The automatic ventilating air filters of the viscous impingement type of the prior art proved to be commercially successful as ventilating air filters; from a time starting in or about 1926 and extending to date, there have been sold, and commercially used, automatic viscous impingement type air filters which operate on the following principles: the filter medium is made of metal-members such as plates, wire screens, sheets or the like; a tank or bath of viscous or oily liquid is associated with the filter and provides a reservoir from which the desired viscous material may be applied to the surfaces of the metal-mem-

bered filter medium; and the "automatic" feature is provided either by means for moving the metal-membered filter medium on an endless track into and through the oil bath or tank, thereby to simultaneously remove at least a portion of the dirtied oil from the surfaces of the medium and to renew those surfaces with a coating of fresher oil, or, the metal-membered filter medium is fixed and from time to time the dirtied surfaces thereof are cleaned and renewed with fresh oil by flushing or otherwise causing oil to move across the fixed surfaces of the medium. Filters constructed according to these principles have been utilized for over thirty years in the automatic filtering of atmospheric dust from air. Such devices have been, and presently are, manufactured and sold by many of the manufacturers of air filtering equipment, including both the plaintiff and the defendant.

26. The disadvantages of the use of such automatic viscous impingement type filters utilizing metal-membered filter media and, in conjunction therewith, a bath or tank of oil, were, and had been, well known to the art. Such disadvantages arose in large part from the presence of the oil bath and of liquid oil and included: periodic removal of a messy oil-dirt sludge from the filtering operation; maintenance and inspection to insure that the oil was being properly applied to the filter media; difficulties and expense caused by the maintaining of, or failure to maintain, the many mechanical moving parts; requirements often made by the Fire Underwriters that fire prevention systems be installed because of the presence of large volumes of oil; periodic inspection is required to insure that oil levels are maintained in the oil bath or tank, that water or other liquid impurities are not present in the oil tank in harmful amounts

and that the type of oil desirable for best operation is used for replacement; problems, caused by the probability that the air, in passing through the filter medium, would remove from the surfaces of that medium excess oil which would be entrained or carried by the air to contaminate some product or area contacted by the filtered air; and periodic manual cleaning of the filter media made necessary, or desirable, by physical entanglement of dust or dirt in the metallic media in such wise that it is not removed by the normal application of fresh oil to the surfaces of the media. Additional draw backs of such filters included excessive weight arising from their metallic construction and necessary appurtenances such as tanks and pumps; and the fact that such filters could not readily be placed in other than a vertical position because of the necessity of maintaining the oil levels and oil flow.

27. The principle upon which the automatic viscous impingement type filters used by the art prior to Rivers' invention operated had been known for over 25 years. Despite the known disadvantages of such filters, these various automatic viscous impingement type filters developed and offered to the trade during this period differed only in design detail and involved no new principles of construction or operation. In that period of over 25 years the development of automatic filters had reached a plateau, in the sense that the workers in the art worked to improve the constructional details of units operating on old principles and developed no new approach to the subject.

28. The development, in about 1926, and, thereafter, the use of these successful automatic viscous impingement type ventilating air filters of the metal-membered medium—

oil tank variety did not eliminate the use of the "unit" filters, whether of the "viscous impingement type" or of the "dry type". Each of these various types of ventilating air filters has, in the years since 1926, sought its own level, that level being primarily determined by the needs and desires of the user. However, because of their automatic features, the automatic viscous impingement type filters came to be used by many who had problems concerning the removal of the larger particles of dirt from relatively large quantities of air.

29. In the period prior to 1954[1] the "unit" type of air filter used as filter medium all of the types of media previously mentioned above in Finding No. 18.

30. Throughout a period of at least twenty years prior to Rivers' conception, disposable unit filters of the viscous impingement type used pads of filamentous filter media of appreciable effective depth having high air handling capacity and large dust holding capacity. These thick pads were inexpensive, were readily fabricated and presented a large effective surface area which could be liberally coated or otherwise treated with a viscous or oily substance and included pads formed of animal hair, certain vegetable fibers, metallic wools and glass wools.

31. Among these relatively thick pads of filamentous materials which had long been used as filter media in viscous impingement type unit filters before 1954 were a group which had expansible-compressible properties in the sense that they were resilient and would, when compressed

[1]The date of commercial introduction of the invention of the patent in suit.

for an interval, return, upon release of compression, to their approximate original thickness. The expansible-compressible properties of such filter media had long been recognized. As early as 1925, it had been recognized that the expansible-compressible properties of such materials could be useful in "unit" types of filters where it was desirable to compress the media during use and to later expand it for cleaning.

32. These relatively thick pads of expansible-compressible filter media used in the "unit" type filters were available to the industry from a very early date. The expansible-compressible properties of these materials were well known and were also utilized in fields other than air filtering. Thick pads or webs of animal hair had widespread use as upholstery material, as well as for air filters. Thick pads or webs of glass fibers had widespread use as house and sound insulation and as resilient pads, as well as for air filters. Metallic wood were commonplace for many uses, as well as for air filters.

33. In the period prior to 1954 the glass fibered filter media became the most popular of the disposable or "throw away" filamentous media because of its relative cheapness, because glass is relatively inert to chemical influence, is fireproof and is light in weight.

34. The expansible-compressible filter media and the specified properties thereof as described and identified in the specification of the patent in suit were, and are, clearly descriptive of a well known and recognized class of filter materials having expansible-compressible properties, and are such as to enable those skilled in the art to readily

identify and use the same. The specific example set forth in the specification clearly describes an example of the filamentous glass material, which, by 1954, had largely commercially displaced other suitable materials for the reasons set forth in Finding No. 33. Any person skilled in the art would have had no difficulty in identifying, obtaining and using, in 1954 or today, the filter media described by way of specific example in the specification of the patent in suit.

35. The well known and recognized class of materials referred to in Findings 31, 32 and 34 is adequately and distinctly expressed in the claims by the terms "expansible-compressible filter medium", "expansible-compressible web" and "permeable expansible-compressible integral web which will return to an expanded state when released from a compressed state".

36. Until Mr. Rivers' invention was commercially offered to the trade in 1954 by plaintiff, the expansible-compressible filter media had only been used in the unit type of air filter.

37. Mr. Rivers did not, by his invention, develop any new filter medium but, instead, merely used the well known expansible-compressible filter media which had long previously been available and which, for many years, had been used in the non-automatic "unit" type of air filters.

38. In its preferred form the method of the Rivers' patent includes providing a supply of the expansible-compressible media in compressed roll form, progressively expanding the media off this roll and across the air stream and then progressively rewinding and compressing the media,

and its contained solids, into another roll which eventually may be conveniently thrown away. This is the form in which plaintiff commercially offered the Rivers' invention to the public in 1954 and this is the form in which defendant appropriated the invention.

39. There was nothing new in the concept of placing a web of filter media in roll form and feeding this web from its supply roll across the air stream to be filtered, and thereafter, rerolling the dirty web into a roll which could be thrown away. Such devices had been suggested many times over the thirty year period preceding Mr. Rivers' invention.

40. Mr. Rivers was the first to propose the novel mode of manipulation of the previously well known expansible-compressible filter media, as set forth in the method claims of the patent in suit, to produce a new class of automatic filters and to, thereby, make possible the commercial use of the cheap filamentous expansible-compressible filter media in automatic air filtering.

41. There was nothing new in winding webs on mandrels for the purpose of convenience in handling and storing.

42. Mr. Rivers was the first to propose that a web of expansible-compressible filter media be formed into a compressed roll on a mandrel and be used as a pre-formed filter media cartridge or package as a direct supply of media for automatic air filtering operations.

43. From all the facts it appears that for many years the experienced workers in the air filtering art had avail-

able to them all of the tools, and all of the basic knowledge used by Mr. Rivers in 1953 in arriving at and carrying out the concepts of his invention. The commercial rewards following from Mr. Rivers' concepts were extensive. In the light of these facts the simplicity of Rivers' concept points to the existence of technological block in the minds of the experienced workers of the art which was not removed until he pointed out the way.

44. The inventions of the patent in suit have created a new class of automatic ventilating air filters.

45. The inventions of the patent in suit have made available for the first time a commercially practical automatic ventilating air filter of the disposable media type.

46. As a result of Rivers' invention, the commerical art of filtering has available, for the first time, a novel, highly practical and useful mode of operation for automatically utilizing the cheap, efficient filamentous filter media of the expansible-compressible type which had long proved to be so useful in the non-automatic types of air filters.

47. The advantages flowing from the use of Mr. Rivers' invention are the following:

(a) For the first time, the useful, cheap and well proven expansible-compressible filamentous media formerly used in non-automatic filters has become conveniently available to automatic filtering.

(b) The filtering art has been provided with an alternative to the long employed automatic viscous impingement type filters which used metal-membered

media and oil tanks and is, thus, in a position to avoid the disadvantages of the older type automatic filters in such instances where such disadvantages are unwanted or not tolerable.

(c) An automatic viscous impingement type filter and filtering method have been provided which, if desired, will operate for periods of many months and up to as long as a year without attention.

(d) The air filtering art is for the first time possessed of a method by which the inconvenience, and uncertainties attendant upon maintenance and interrupted performance is reduced to a minimum.

48. Mr. Rivers' inventions as described and claimed in the patent in suit include a new mode of operation and the clothing of apparatus elements with new functions.

49. The patentee has provided an entirely new mode of manipulative operation and thereby has effected an old result i.e. the filtering of air, in a novel way which eliminates procedural disadvantages previously suffered in automatic air cleaning. The patentee's invention brings no improved result insofar as the cleaning of the air is concerned because the old filter media which is subjected to the patentee's new mode of manipulative operation does not, thereby, become enhanced in its air cleaning properties.

50. The customers to whom filters are sold are, for the most part, of a type well qualified to independently judge the usefulness of the product.

51. The response of the trade to the patented inventions was spontaneous, immediate and substantial. There

was immediate widespread acceptance and demand for the invention.

52. Automatic viscous impingement type air filters embodying Mr. Rivers' invention were an immediate success. In the first two years of their introduction plaintiff sold about $1,800,000 worth of such filters. In the period up to January, 1959, plaintiff sold more than 12,000 sections for a total gross sales value of over $8,000,000.

53. The commercial success of plaintiff in marketing air filters embodying Mr. Rivers' invention took place without the help of more advertising than plaintiff normally expended on any of its many air filter products.

54. The patentee's invention has been successful despite the fact that it does not necessarily effect its automatic air cleaning result in an operating cost lower than that previously encountered in obtaining an equal result of air cleaning by the previously used automatic machines. Often the use of the patentee's invention increases the operating cost.

55. The patented inventions are displacing the automatic viscous impingement type ventilating air filters of the prior art.

56. The prior art, and other material, upon which defendant relies for its defense of invalidity, is, in all material respects, the same as, or is not substantially different than, the prior art known by, and the admissions of fact considered by, the United States Patent Office prior to the grant of the patent in suit.

57. The arguments advanced by defendant contra the validity of the patent in suit, are in all material respects the same as, or similar to, the matters considered by the United States Patent Office prior to the grant of the patent in suit.

58. The Patent Office Examiner who handled the application for the patent in suit also concurrently handled an application for patent on plaintiff's "Auto-Airmat" unit and affidavits filed in the latter application clearly showed that "Auto-Airmat" units were made and sold long prior to one year before the filing of the application for the patent in suit.

59. The Patent Office was in no way misled by the applicant or his attorneys during the prosecution of the application for the patent in suit. In fact the following admissions made by the applicant before the Patent Office Examiner are as good, or better, than any of the prior art upon which the defendant has relied:

> "The gas filtering art is not a new one; it is, in fact, a crowded art in which much effort has been expended over a long period of time in devising apparatus by which large volumes of gas could be cleaned by devices requiring a minimum of maintenance cost and attention. Expansible-compressible filter media have long been known in this art. The principle of passing a filter medium from one point to another point and, intermediate thereof, through a filtering area is certainly an old concept. Yet it appears that only the applicant has thought to use a method or apparatus in which the expansible-compressible material is first compressed into a pack-

aged supply, is thereafter released from that supply, expanded, passed through the filtering area and thereafter recompressed or otherwise conditioned to a readily disposable state. In so doing, applicant has removed expansible-compressible filter media from its restricted use as a fixed filter into a sphere where it can be conveniently, automatically and progressively presented to a filtering job thus fully and effectively utilizing the highly desirable properties of such media."

60. None of the prior art upon which defendant relies teaches or discloses the inventions of the patent in suit, nor does it, taken alone or in combination, provide any teaching or disclosure that can be considered to render the inventions of the patent in suit obvious or apparent to those skilled in the art.

61. The defendant did not copy the prior art but rather copied the device described and claimed in the patent in suit.

62. Defendant makes and sells a preformed package of filter medium for use in its "Roll Kleen" filters. This preformed package consists of a web of about 70 feet of permeable glass fiber filter media convolutely wound upon a mandrel member sized and arranged for direct insertion into the "Roll Kleen" filter. The media has an expanded thickness of 2 to 3 inches and is wound in compressed condition upon the mandrel into a roll of about 13 inches in diameter with the convolutely wound layers thereof being about 15/100 of an inch in thickness. The media is of such character as to return to its expanded state when released from its compressed state. This preformed package cor-

responds both in form and substance with Claim 1 of the patent in suit and said claim is infringed thereby.

63. In the operation of the defendant's "Roll Kleen" filter an expansible-compressible filter medium (of the character set forth in Finding No. 62) is progressively removed from a compressed supply web thereof, moved into and through an air stream in expanded condition and, after exposure in the air stream to accumulate air borne contaminants, is thereafter progressively recompressed into a convolutely wound roll to form a disposable package thereof. This operation corresponds both in form and substance with the subject matter of method Claims 2 and 3 of the patent in suit and each of said claims is infringed thereby.

64. Defendant's "Roll Kleen" filter employs, as a filter medium, an elongate permeable expansible-compressible integral web that will return to an expanded state when released from a compressed state (of the specific character set forth in Finding No. 62). The "Roll Kleen" filter includes a frame defining an air filtering area and a passage for air through said area, a housing disposed at one side of the air filtering area to receive and locate a supply of precompressed filter mediums and defining a supply zone, a second housing located to receive the filter medium at a point beyond said air filtering area and defining a discharge zone with said two housings defining, with said air filtering area a path of filter medium advance. The "Roll Kleen" filter includes a rewind mandrel and a motor drive and associated controls therefor that serves to progressively displace the precompressed medium in the supply zone from its compressed state, through said air filtering area and into the discharge zone. Also included is a backing strip of Leno-weave cloth on the media which cooperates with

the driven rewind mandrel to effect a compression of the expanded media on said mandrel as the same is convolutely rewound thereon and to thereby progressively condition the media into a disposable state. This structure and operation corresponds both in form and substance with the subject matter of apparatus Claims 4 and 5 of the patent in suit and each of said claims is infringed thereby.

65. The structure and operation of defendant's Type H. Roll Kleen is the same as that set forth in Findings Nos. 62-64 for the standard Roll Kleen filter except that the media is moved in a horizontal rather than a vertical path. The structure and operation of the Type H. Roll Kleen corresponds both in form and substance with the subject matter of Claims 1-5 of the patent in suit in the same particulars as set forth in the above mentioned findings and each of said claims is infringed thereby.

CONCLUSIONS OF LAW

A. United States Letters Patent No. 2,807,330 in suit was duly and legally issued to Plaintiff, American Air Filter Company of Louisville, Kentucky; said Plaintiff is the owner of the entire right, title, and interest in and to said Letters Patent, together with any and all rights of action, claims, or demands arising out of or accruing from past infringement thereof.

B. United States Letters Patent No. 2,807,330 complies fully with all of the provisions of Title 35, United States Code, discloses and claims a patentable invention, and is not anticipated by any prior art.

C. United States Letters Patent No. 2,807,330 is good and valid in law as to all of the claims thereof; said patent claims cover a new and meritorious invention.

D. United States Letters Patent No. 2,807,330 constitutes a marked advance in the art and is entitled to a liberal construction of its terms.

E. Defendant has infringed Claims 1 through 5 of United States Letters Patent No. 2,807,330 by the manufacture and sale of its "Roll Kleen" filters.

F. Defendant has infringed Claim 1 of United States Letters Patent No. 2,807,330 by its manufacture and sale of initially installed media and replacement media for its "Roll Kleen" filter.

G. Plaintiff is entitled to a judgment for an injunction and accounting with costs as prayed for in the Complaint filed herein.

THE CONSTITUTIONAL PROVISION

Art. I, § 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries;

EXCERPTS FROM TITLE 35, UNITED STATES CODE

§ 101. Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§ 282. Presumption of validity; defenses.

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability . . .

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In the Supreme Court of the United States

OCTOBER TERM, 1965.

No. 764.

AMERICAN AIR FILTER COMPANY, INC.,
Petitioner,

v.

CONTINENTAL AIR FILTERS, INC.,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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AMERICAN AIR FILTER COMPANY, INC.,
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v.

CONTINENTAL AIR FILTERS, INC.,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

American Air Filter Company, Inc., plaintiff below, has petitioned for a Writ of Certiorari to review the Judgment of the United States Court of Appeals for the Sixth Circuit holding invalid Rivers Patent No. 2,807,330. The decision of the Court of Appeals is printed in the Appendix hereto.

QUESTION PRESENTED.

The single question presented by the Petition is whether or not the court below erred in holding the Rivers patent invalid for lack of patentable invention.

STATEMENT OF THE CASE.

The present case is an ordinary patent infringement action in which the Rivers patent was adjudicated as invalid by the District Court[1] and the Court of Appeals.[2] The patent was also held invalid by the United States

[1] 226 F. Supp. 482.

[2] Page 6, *infra.*

Court of Appeals for the Ninth Circuit,[3] certiorari denied, 375 U. S. 903.

The Rivers patent relates to the filtering of air by passing it through a web of an old type of "expansible-compressible" filter media of which a supply is provided in the form of a web wound under compression on a roll, and which is unwound and moved across the air stream and then rewound under compression after it has become soiled with solids filtered from the air. The precompression or post-compression of the filter media has no effect on its filtering properties in the air stream. The action of the Rivers apparatus may well be compared with the method of drawing the film from one spool to another across the light chamber of a camera.[4] Petitioner has conceded that neither the filter medium nor the apparatus used to draw it into and through the airstream was new.[5] The Rivers filter did no better job of filtering air than had been done before; the method of operation was not new; the filtering medium was not new.[6]

Contrary to the impression which the Petition seeks to create, the court below did rely upon Sec. 103 of Title 35 U. S. C. in adjudicating patent invalidity. The court below said (page 7, *infra*):

> "As stated by the Ninth Circuit, the patentee, Rivers, 'did contribute something to the art' and the sole question is whether such contribution constituted patentable invention, 35 U. S. C. A. Sec. 101, *and was something that would not have been 'obvious at the time the invention was made to a person having ordinary skill in the art to which said subject*

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[3] 318 F. 2d 500.

[4] Opinion below, *infra*, page 9.

[5] *Ibid*, 10.

[6] *Ibid*, 14.

matter pertains,' 35 U. S. C. A. Sec. 103." (Emphasis added.)[7]

The court below answered this question by holding that the Rivers concept is too obvious to be patentable. This holding resulted from an independent examination of the entire record of the case from which the court concluded "as a matter of law that plaintiff's patent is invalid."[8]

ARGUMENT.

At best the Rivers concept represents a slight technological advance which both courts below as well as the Ninth Circuit found to be unpatentable. In *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U. S. 225 (1964), this Court recognized the danger in granting such patents by stating (p. 230):

> "To begin with, a genuine 'invention' or 'discovery' must be demonstrated 'lest in the constant demand for new appliances the heavy hand of tribute be laid on each slight technological advance in an art.' Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84, 92, 62 S. Ct. 37, 41, 86 L. Ed. 58 (1941); see Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147, 152-153, 71 S. Ct. 127, 130, 95 L. Ed. 162 (1950); Atlantic Works v. Brady, 107 U. S. 192, 199-200, 2 S. Ct. 225, 230-231, 27 L. Ed. 438 (1883)."

The opinion of the lower court shows that the Rivers concept did not meet the conditions and requirements prescribed in Section 103 of the Patent Act. In its opinion the lower court did refer to Section 101 in posing the sole

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[7] Italicized portion of quotation omitted by Petitioner in its quotation at page 5.

[8] Opinion below, *infra*, page 15.

question as to whether the Rivers contribution constituted *patentable* invention but coupled this with a quotation of the pertinent language of Section 103 and also cited that section.

The heading of Section 101 is "Inventions Patentable." It provides that "Whoever invents or discovers * * * may obtain a patent therefor, subject to the conditions and requirements of this title." Therefore, to be patentable an invention must meet the conditions and requirements for patentability set forth in the sections following 101, including Section 103. This is the exact approach which the lower court followed in arriving at its conclusion: "as a matter of law that plaintiff's patent is invalid."

After making an independent examination of the entire record the lower court said (*infra*, page 15):

> "We agree with the District Judge and the Ninth Circuit in holding that the concept *is* too obvious to be patentable."

Thus, there was no "superposition" of a judicially enunciated standard of invention. Because the Rivers concept was obvious under the provisions of Section 103, a condition for patentability was not met and Rivers did not qualify for a patent under Section 101. There is no language in the opinion of the lower court which would justify the assertion that the court below applied any test other than the test of obviousness of Section 103.[9]

Petitioner has failed to show that the court below did not apply the proper standard in determining lack of patentable invention. Petitioner's argument based upon

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[9] Another defense which the court below found unnecessary to consider is that the patent is invalid for overclaiming (*infra*, page 15).

the contrived and obscure question presented in the Petition ignores the reliance of the court below upon the applicable provisions of the present Patent Act. Any doubt as to this is dispelled by a reading of the carefully considered opinion of the court where both the prior art and the nature of Rivers' contribution are discussed.

CONCLUSION.

The disposition of this action by the lower court was on no different basis than that on which numerous other patent infringement actions have been determined. The opinion of the United States Court of Appeals for the Sixth Circuit raises no issue of patent law which should be decided by this Court. Two courts of appeals have concurred in holding the Rivers patent invalid. The Petition indicates nothing more than the dissatisfaction of a private litigant and presents no valid reason for review.

It is respectfully submitted that the Petition should be denied.

CARL F. SCHAFFER,
Attorney for Respondent.

APPENDIX.

OPINION OF THE COURT OF APPEALS.

No. 15725.

UNITED STATES COURT OF APPEALS

FOR THE SIXTH CIRCUIT.

AMERICAN AIR FILTER COMPANY, INC.,

Plaintiff-Appellant,

vs.

CONTINENTAL AIR FILTERS, INC.,

Defendant-Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF KENTUCKY.

Decided June 25, 1965.

Before CECIL and O'SULLIVAN, Circuit Judges, and KENT, District Judge.

O'SULLIVAN, Circuit Judge. This appeal asks reversal of a judgment holding invalid U. S. Patent No. 2,807,330, owned by plaintiff-appellant American Air Filter Company, Inc. as assignee of the alleged inventor, Richard D. Rivers. Plaintiff American brought this action charging infringement of the patent against defendant-appellee Continental Air Filters, Inc. in the United States District Court for the Western District of Kentucky. The District Judge, having heard the proofs in the case at bar, withheld decision until the Ninth Circuit announced its opinion in *Farr Co. v. American Air Filter Co.*, 318 F(2) 500 (1963), *cert. denied*, 375 U.S. 903 (1963), holding the same patent invalid. The District Judge followed this deci-

sion in his opinion, which is reported as *American Air Filter Co. v. Continental Air Filters, Inc.*, 226 F. Supp. 482 (W.D. Ky. 1963). He ruled that,

> "While it is recognized that the holding of the Ninth Circuit that the patent in suit is invalid is not controlling here, yet it should be followed unless the decision discloses 'a very palpable error in law or fact.' Cold Metal Process Co. v. E. W. Bliss Co., 285 F.2d 231, 236 (6th Cir. 1960); Cold Metal Process Co. v. Republic Steel Corp., 233 F.2d 828, 837 (6th Cir. 1956); Cincinnati Butchers' Supply Co. v. Walker Bin Co., 231 F. 453, 454 (6th Cir. 1916)." 226 F. Supp. 482.

Fair reading of the District Judge's reported opinion together with his conclusions of law and the opinion of the Ninth Circuit makes it clear that invalidity was adjudged because of the conclusion that *as a matter of law* the patentee, Rivers, really did not *invent or discover* anything when he put together the patented mechanism. 35 U.S.C.A. § 101. We agree with the District Judge and the Ninth Circuit and, therefore, affirm.

The patent here involved relates to a method and material for operating air filtering equipment. The growth of the air filtering industry, like others in this mechanical age, has been characterized by continuing improvement. As stated by the Ninth Circuit, the patentee, Rivers, "did contribute something to the art" and the sole question is whether such contribution constituted patentable invention, 35 U.S.C.A. § 101, and was something that would not have been "obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C.A. § 103.

Air is commonly filtered by passing it against and through a screen or obstruction of such material as to

strain out some or all of its various contaminants.[1] A variety of such straining materials—referred to in this context as the filtering media—have been employed to meet particular needs. Such media have been made of cloth, metal, Fiberglas and other materials. Some are dry, relying on the obstructive qualities of the material; others are known in the industry as the viscous impingement type. In the latter media, the screening material is treated with some viscous (oily) substance which adds to its filtering capacity by giving it a tacky quality similar to fly paper. We deal here with such media.

For a period prior to the application for the patent in suit, August 4, 1954, filtering media with components of Fiberglas and other materials treated with viscous substances had come into use. Plaintiff's version of this product was trade-named Amer-glas. Plaintiff does not claim

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[1] Appellant's brief describes these contaminants as follows:

"Solid contaminants are broadly classified as atmospheric dust and process dust.

"Process dust includes particulate matter generated by or associated with some industrial process. It is usually homogeneous in character, frequently covers a rather narrow range of particle sizes and usually occurs in high concentrations. Sawdust from woodworking machinery, lint from paper and textile fabricating and processing operations, lint and ink mist from newspaper pressrooms and cement dust from kiln operations are examples of process dusts.

* * * * *

"Atmospheric dust refers to particulate matter commonly found in the atmosphere of a particular area or location in question. It generally covers a wide range of particle sizes varying from submicron dimensions up to particles of a visible nature, occurs in relatively low concentrations and is quite heterogeneous in nature. Its constituents vary with the geography of the location, the season of the year, the wind direction and other general factors. Typical constituents may include minute particles of clay, silica, smoke, soot and carbon, decayed animal and vegetable matter, organic particles such as plant fibers, lint and pollen as well as mold spores, bacteria and other microorganisms."

that this medium represented an inventive advance, and other manufacturers developed similar media. It was characterized as an "expansible-compressible filter medium" which could be tightly wound on a spool or mandrel, reducing its thickness, but which resumed its original thickness upon unwinding, not unlike the unrolling of a package of cotton. This compressible quality had been useful to reduce the bulk of the material for shipment and storage.

These differing media have been presented to the contaminated air by several types of installations. These types are broadly divided into automatic and unit varieties. In the automatic group the filtering medium is moved through the airstream by mechanical means, while the unit style places the filtering medium in a fixed apparatus which is manually removed when necessary for cleaning or replacement. In one common type of automatic filter the filtering medium (usually metal screens) is mechanically moved through the airstream, and then on through an oil bath at the bottom of the apparatus which cleans it and renews its tacky or viscous quality. In both the automatic and the unit types the filtering medium was sometimes taken out of the apparatus and either disposed of or, in other styles, cleaned, treated and reused.

The general plan of the Rivers patent was to place a roll of the expansible-compressible viscous impingement filter medium at the top of an apparatus and to have it automatically unwound and passed through the airstream to be rewound on another spool at the bottom of the machine to await disposal. The action may well be compared with the method of drawing the film from one spool to another across the light chamber of a camera. The patentee describes what is claimed as invention in his claim 2.

"2. In a method of filtering from an air stream solids borne thereby, the steps consisting of progressively

> removing and expanding from a compressed supply web thereof and [sic] expansible-compressible filter medium, moving the medium into and through said air stream and thereafter progressively recompressing the thus exposed medium, carrying the solids retained in it, into a disposable package."

We need not consider any of the other claims of the patent because plaintiff concedes that "if method claim 2 is invalid for lack of 'invention' all of the other claims are likewise invalid for the same reason."

Plaintiff markets the product of its claimed patent under the trade name of Roll-O-Matic. Plaintiff concedes that neither the filter medium nor the apparatus used to draw it into and through the air-stream was new. He contends that the claimed invention resides in the combining of such well known components into a new method of operation. Thus the use of an upper and lower spool for unwinding the filter media and rewinding it after passing it through the air stream was clearly disclosed in the Christofferson patent No. 1,982,639 issued December 4, 1934, and was at least suggested in other prior art. Plaintiff points out that the Christofferson patent was not designed for use with the viscous impingement type of filter media and that it had never been put to commercial use. This is true, but the plaintiff itself as early as 1949 or 1950 had put to commercial use its own "Auto-Airmat" which as described by plaintiff's witness "has a roll at the top and feeds media across an air stream and is rewound at the bottom." The Auto-Airmat, however, used a dry medium as distinguished from the viscous impingement medium used in plaintiff's Roll-O-Matic.

After Rivers' application for the patent in suit, the defendant developed a machine for the use of a viscous impingement medium similar to plaintiff's Amer-glas, and

now markets it under the style of Conomatic. Defendant concedes infringement if the Rivers patent is valid.

In view of the informative material in the Ninth Circuit's decision in *Farr* and the District Judge's reported opinion in the case at bar, reference to them will supplement our writing and probably better describe the contest we deal with. We have gone into some background detail, however, to demonstrate the fact that we arrive at the conclusion we do upon our own evaluation of the evidence, aided and supported of course by the good reasoning of the Ninth Circuit in its *Farr* decision. Appellant suggests that the District Judge did not independently arrive at his conclusion of invalidity, but merely accepted as dispositive the *Farr* decision. We do not so read the District Judge's opinion, especially as we have examined the Findings of Fact and Conclusions of Law which supplement his reported opinion. His Findings of Fact are adequate and are not in substantial conflict with what appellant claims here. The following are his decisive Conclusions of Law.

> "1. The standard of patentability is a constitutional standard; and the question of the validity of a patent is a question of law.
>
> "2. The nature of Rivers' contribution in view of the state of the prior art does not meet the standards of patentable invention.
>
> "3. Each of the claims of the patent in suit is invalid. *Farr Company v. American Air Filter Company, Inc.*, 318 F.2d 500 (C.A. 9)."

The basic facts from which we must determine whether the Roll-O-Matic air filter contains "invention" are not in dispute and the question, therefore, is to be resolved as a matter of law. *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F(2) 406, 409-11 (CA 6, 1964), *cert. denied*, 379 U.S. 888 (1964). This essential

agreement on the basic facts, reflected in the Findings of Fact plaintiff proposed to the District Court, obviates the need for further detailed analysis of the proofs. Such proposed Findings contain the following:

"15. Among these relatively thick pads of filamentous materials [filter media], which had long before 1954 been used as filter media in unit viscous impingement type filters, were a group which had certain physical properties in the sense that they were resilient and, when compressed for an interval, would return, upon release of compression, to their approximate original thickness. These properties of such filter media had long been recognized. As early as 1925, it has been recognized that such properties of such materials could be useful in 'unit' types of filters where it was desirable to compress the media during use and to later expand it for cleaning. * * *

"16. The relatively thick pads of resilient filter media used in the 'unit' type viscous impingement filters were available to the industry from a very early date. The resilient properties of these materials and of materials of a generally similar nature were well known and were also utilized in fields other than air filtering where resilience to accept compression was of value.

* * *

"17. In the period prior to 1954, the glass fiber filter media became the most popular one of the disposable or 'throw away' viscous impingement type media because of its relative cheapness, and its fireproof character."

"26. There was nothing new in the concept of placing a web of media in roll form and feeding this web from its supply roll across an air stream and thereafter rerolling the dirty web into a roll which could be thrown away. Such devices had been suggested many times over the 30 year period preceding Rivers' invention.

"27. All of the tools used by Rivers in the practice of his new mode of operation had long been available in the filtering art."

"30. Rivers did not develop any new material or propose the use of any new filter media. The materials contemplated by Rivers as those adapted to his new mode of operation were expansible-compressible materials which had been available for many years. Among these were specific materials which by reason of cheapness, availability and other favorable considerations had been extensively used as disposable media in the unit 'viscous impingment type' filters."

"45. * * * The patentee's invention brings no improved result insofar as the cleaning of the air is concerned, because the old and well recognized class of filter media, which is subjected to the patentee's new mode of manipulative operation, does not thereby become enhanced in its air cleaning properties."

Notwithstanding the foregoing, plaintiff insists that Rivers was entitled to a patent monopoly because he was the first to use the roll type method of automatically presenting the filter media to the air stream, suggested by the early Christofferson and other patents and commercially employed by plaintiff in its own Auto-Airmat, in combination with the well known Fiberglas viscous impingement type media. We are aware that the simplicity of an idea does not *forbid* its patentability, *e.g., Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279, 88 L. Ed. 721, 724 (1944); *Monroe Auto Equip. Co. v. Superior Inds.*, 332 F(2) 473, 477 (CA 9, 1964), *cert. denied*, 379 U.S. 901 (1964); *Allen v. Standard Crankshaft & Hydraulic Co.*, 323 F(2) 29, 34 (CA 4, 1963); *Mott Corp. v. Sunflower Inds.*, 314 F(2) 872, 880 (CA 10, 1963); *Application of Shelby*, 311 F(2) 807, 810 (C.C.P.A. 1963), but to rise to invention a combination of old elements must "co-act to produce the result achieved, the result must be

new and useful, and the method of operation must be new." *Cold Metal Process Co. v. Republic Steel Corp.*, 233 F(2) 828, 838 (CA 6, 1956), *cert. denied*, 352 U.S. 891, 1 L. Ed.(2) 86 (1956). The Roll-O-Matic did not bring about any new ultimate results—it did no better job of filtering the air than had been done before; the method of operation was not new; the filtering medium was not new. All that can be said of Rivers' idea was that he was the first to use the Fiberglas medium in the basic apparatus that had been "suggested" by Christofferson and had been put to commercial use by plaintiff's Auto-Air-mat. The fact that Rivers was the first to do this will not alone endow his idea with inventiveness.

> "He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satisfied with whatever fame, personal satisfaction or commercial success he may be able to achieve. Patent monopolies, with all their significant economic and social consequences, are not reserved for those who contribute so insubstantially to that fund of public knowledge." *Dow Chemical Co. v. Halliburton Oil Well Cementing Co.*, 324 U. S. 320, 328, 89 L. Ed. 973, 980 (1945).

We think it appropriate to add the following from *Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 153, 95 L.Ed. 162, 167 (1950):

> "This patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly."

Plaintiff, conceding that the old Christofferson patent *suggested* the basic plan of the Rivers apparatus, argues in effect that because it had not been put to use it cannot be considered to have anticipated the patent in issue. As-

suming such rule, however, the early patent may be considered on the question whether the Rivers concept is too obvious to amount to patentable invention. *Monroe Auto Equip. Co. v. Heckethorn Mfg. & Supply Co.*, 332 F(2) 406, 414-15 (CA 6, 1964), *cert. denied*, 379 U.S. 888 (1964). We agree with the District Judge and the Ninth Circuit in holding that the concept *is* too obvious to be patentable.

Appellant argues that the District Judge misapplied the doctrines of comity in adopting the *Farr* decision "as the law of this case." Our review of the District Court opinion and its Findings of Fact and Conclusions of Law satisfies us that the District Judge made his decision from his own evaluation of the record before him and did no wrong in finding persuasive and adopting for his decision the law announced by *Farr*. In discharging our appellate responsibility, we have examined the entire record of this case and independently of, but aided by, the Ninth Circuit reasoning in *Farr*, we conclude as a matter of law that plaintiff's patent is invalid. Being impressed with the reasoning of the *Farr* case, we have found it unnecessary to go into any more detailed discussion of the facts of this case and the law that applies to them.

Our decision makes it unnecessary to consider the defendant's claim that the Rivers patent is invalid for overclaiming.

Judgment affirmed.

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JAN 4 1966
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM 1965
No. 764

AMERICAN AIR FILTER COMPANY, INC.,
Petitioner,

v.

CONTINENTAL AIR FILTERS, INC.,
Respondent.

PETITIONER'S REPLY TO RESPONDENT'S BRIEF

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Respondent's brief emphasizes the vice inherent in the action taken by the Sixth Circuit Court of Appeals. In fact, if the procedures followed below are characteristic of "an ordinary patent infringement action"[1] no more cogent argument could be made for the need for exercise of this Court's supervisory authority to delineate the necessary criteria for a uniform judicial administration of the patent laws.

Respondent's statement relies heavily upon two purported "facts" which were uniquely "found" for the first time by the Court of Appeals and on which it relied in reaching its conclusion of invalidity for lack of "invention". One of these was an asserted concession[2] by petitioner that

[1]Respondent's Brief, p. 1.
[2]See Respondent's Brief, p. 2.

the "apparatus" was old and the other was an assertion that "the method of operation was not new".

To merely state the above shows the unreal state to which we have now come since, if such assertions are factually correct, both the apparatus and method claims of the patent in suit would clearly and unequivocally be invalid for lack of novelty under 35 U. S. C. § 102 and the defence of lack of "invention" would never need be reached. Apart from the questionable propriety of the appellate court's assumption of the trial court's fact finding responsibility, it is significant to note that the District Court below made no such findings of lack of novelty, nor did either the trial or appellate courts in the companion Farr Company case.[3] Quite to the contrary, the requisite novelty of the claimed subject matter was expressly found and accepted in the Farr case and there, as here, the sole issue was one of "invention"[4] and the standards determinative thereof. Likewise, the fact findings of the District Court below are singularly devoid of any such assertion of lack of novelty or even of facts from which such an assertion could be inferred.

As pointed out in the petition (p. 8), the Court of Appeals mentioned 35 U. S. C. § 103 only as a make-weight after having found the patent invalid by virtue of some undefined standard of invention embodied in § 101 of the statute. In so doing, however, it necessarily relied upon its own erroneous fact findings discussed above[5] and then compounded the error by erroneously asserting that the District Judge below and the Court of Appeals for the Ninth Circuit Court both *held* that the patent was invalid because of obviousness under § 103. The record, however, is expressly

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[3]See Petition p. 2-3.

[4]See Petition p. 3.

[5]Apparently on assumption that if the method and apparatus were old, they must have been known and hence were "obvious".

to the contrary. The District Court in the Farr case expressly found that the claimed subject matter was not obvious (See Findings 60, 22, 24; Appendix to Petition pp. 28a, 16a, 17a). The Ninth Circuit Court accepted the fact findings of the District Court[6], never considered or even mentioned the subject of obviousness and turned its decision on an asserted failure to meet a purported "standard of invention" which required the presence of "unusual or surprising consequences".[7] The District Court below, as a concomitant to its express adoption of the "ruling and reasoning" of the Ninth Circuit opinion "as the law of the case," adopted fact findings that are either quotes from or slightly paraphrased extracts of such opinion and nowhere therein is there any finding or statement that would show any consideration of the issue of obviousness by the trial court. (See Appendix to Petition, pp. 1a-5a)

Respondents brief emphasizes not only the negation of the statutory standards of patentability by the courts below, but also the inevitable performing of the fact finding function of the trial court by the appellate court that accompanies the same. In the case here presented we have a situation wherein the only trier of the facts who considered the case on the facts of record before him, *i.e.*, the District Court in the Farr case, found the patent valid and infringed and made detailed fact findings with respect thereto. The Ninth Circuit Court did not disturb these findings and reversed solely for lack of invention because of the purported lack of certain undefined but yet "requisite unusual or surprising consequences". The District Court below expressly adopted the Ninth Circuit opinion and found a set of facts in accordance with the wording of such opinion. The Sixth Circuit Court, in affirming, not only applied

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[6]See 318 F. 2d 500, 502.

[7]*Ibid* p. 502-3.

erroneous standards of invention but, in conjunction therewith, uniquely found as facts certain matters which were not only clearly erroneous but which were also contrary to the holdings and findings of every court which has previously considered this matter.

The petition in this action raises a question fundamental to the judicial administration of the patent laws which should be resolved by this Court.

Respectfully submitted,

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